



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/484,721	01/18/2000	Kozo Yokoyama	FUJH16.825	1024

7590 11/21/2003

KATTEN MUCHIN ZAVIS ROSENMAN  
575 MADISON AVENUE  
NEW YORK,, NY 10022-2585

EXAMINER
----------

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/484,721

Applicant(s)

YOKOYAMA, KOZO

Examiner

Tan Dean Nguyen

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-7,9,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3,5-7,9,11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

The amendment filed 3/31/03 has been entered.

***Response to Arguments***

The abandonment of 5/6/03 has been withdrawn.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 3, 5-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter). In the present case, claims 1, 3, 5-6 is directed to a "method for controlling replacement of plural terminal equipment in a building management system", which is not within one of the classes of invention set forth in § 101.

The process for "controlling replacement of plural terminal equipment in a building management system" comprising (a) tabulating step and (b) switching hard addresses corresponding to the points to be managed are merely an abstract idea and do not produce a useful, tangible, concrete results.

The process for "controlling replacement of plural terminal equipment in a building management system" are merely an abstract idea and does not involve any

Art Unit: 3629

computer or structural means to carry out any functions and therefore are found to be non-statutory subject matter.

***Claim Rejections - 35 USC § 112***

3. Claims 1, 3, 5-6, 7, 9, 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 calls for a “method for controlling replacement of plural terminal equipment in a building management sytem” as shown in the preamble but fails to include the term “replacement” in the body of the claims. Also, on line 8, the phrase “the tabled connecting status” lacks antecedent basis.

Also, 2<sup>nd</sup> step “switching ... new terminal equipment” is vague and indefinite because it's not clear what is being claimed and the relationship between “tabled connecting status” and “correspondence” and how all of this relating to the “controlling replacement” of the plural terminal equipment.

Claims 3, 5-6 are written in passive/inactive state which are vague and indefinite for a method claim. Conversion the claim language in active/positive state is recommended to improve clarity.

Claim 7 calls for a “system for controlling a replacement of plural terminal equipment in a building management system” as shown in the preamble but fails to include structural related to or means for “controlling a replacement” in the body of the claims.

Claims 7, 9, 11-12 are written in passive/inactive state which are vague and indefinite for an apparatus claim. Conversion the claim language in active/positive state showing the structures or elements or the apparatus is required to improve claim clarity. Note that manner or method in which a machine or system is to be operated is not germane to the issue of patentability of the system itself. See In re Casey 152 USPQ 235 (238) CCPA 1967. For example, in claim 7, phrases such as "terminal equipment is used", "points to be managed", "wherein the hard address corresponding to the point to be managed is switched ...." And "center device is controlled" is vague since these are not structures but merely method steps.

***Claim Rejections - 35 USC § 103***

4. Claims 1, 3, 5-6, 7, 9, 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over ALLEN et al (US Patent 5,680,113).

As for claim 1, ALLEN et al discloses a method for controlling replacement of plural terminal equipment comprising the steps of: (a) tabulating a connecting status showing existing terminal equipment is used in each point to be managed and correspondence between hard addresses of existing terminal equipment and replacement, and (b) switching hard addresses corresponding to the point to be managed according the connecting status of the existing terminal equipment or replacement and the correspondence between the hard addresses of the existing terminal equipment and the replaced terminal equipment (see Figs. 1, 4, col. 2, lines 1-30, col. 6, lines 5-65, col. 8, lines 1-60). As for the limitation of "in a building management system" in the preamble, this carries little patentable weight since it

Art Unit: 3629

appears only in the preamble and not in the body of the claims. Moreover, it would have been obvious to apply the general teaching of "replacing equipment" in other similar environment facing problems of replacing equipment as in a building management. Also, the tabulating of a connecting status showing existing terminal equipment is used in each point to be managed is shown on Fig. 4 and alternatively, this would have been obvious as a matter of choice in view of the general teaching as shown on Fig. 4.

As for claim 3, the use of a flag for error or indication of other desired event would have been obvious in view of the teaching on col. 10. As for claims 5-6, ALLEN et al disclose a test procedure of error status (col. 12). The use of test mode for other procedure would have been obvious if desired.

As for claim 7, ALLEN et al discloses a center device having a table for a connecting status showing existing terminal equipment (Figs. 2, 3, 4), existing terminal equipment which is connected to the device (Figs. 2, 3, 4), and the capability for switching hard address corresponding to the point to be managed (Cols. 6, 7, 8). As for claims 9, 10-11, they are rejected for the same reasons set forth in claims 3, 5-6 above.

Art Unit: 3629

***Response to Arguments***

5. Applicant's arguments, see Amendment A, filed 3/31/03, with respect to claims 1-4, 7-10 have been fully considered and are persuasive. The rejections of claims 1-4, 7-10 over Barrett in view of Kojima et al have been withdrawn.

6. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .


Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn

  
DEAN T. NGUYEN  
PRIMARY EXAMINER